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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,407	07/24/2003	Samih Tarabichi	8696-1	1058

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EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT PAPER NUMBER

3736

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/626,407	Applicant(s) TARABICHI, SAMIH	
	Examiner Jeffrey G. Hoekstra	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

1. In response to the amendment filed on 01/09/2007, amendment(s) to the specification, amended claim(s) 1, and canceled claim(s) 3, 4, and 6 is/are acknowledged. The current rejections of the claim(s) 1-11 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner contends the newly added limitation "the dynamic spacer resides completely internally to the knee during said arthroplasty" was not properly described in the specification or drawings as filed and constitutes new matter. The Examiner notes the drawings do not show or indicate the relationship of the dynamic spacer to any anatomical landmarks.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention positively recites the knee as a structural limitation and is thus directed to a judicial exception to 35 U.S.C. 101 (i.e. a natural phenomenon, specifically anatomy) and is not directed to a practical application of such judicial exception (e.g., because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result). Structurally, the combination of the dynamic spacer and knee as claimed may functionally measure the flexion and extension gaps during knee arthroplasty but as claimed does not produce a useful, concrete, and tangible result and alternatively produces an abstract idea (i.e. the unclaimed measurement data) and abstract transformations thereof.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuke et al (US 5,800,438) as broadly as structurally claimed.

8. For claim 1, Tuke discloses a dynamic spacer for measuring the flexion and extension gaps during knee arthroplasty having parallel first 1 and second 8 planar members with lower 40 and upper 41 surfaces engaging tissue surfaces, respectively,

wherein said members fixedly attach a tensioning means shown in Figure 2, and wherein said dynamic spacer is capable of residing completely internally to the knee during said knee arthroplasty (for example an elephant knee).

9. For claim 2, Tuke shows the spacer is used for measuring distance between said first and second planar members (column 3 line 66).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuke et al in view of Muhs et al (US 5,701,370) as broadly as structurally claimed. Tuke discloses the claimed invention except for a means for measuring angulation. Muhs teaches the measurement of various rotation angles in a knee (column 3 line 33) as a planar member deviates from parallel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the measurement device as taught by Tuke, with the measurement device as taught by Muhs for the purpose of increasing the efficacy of a total knee arthroplasty by increasing surgical success via measuring anatomical constraints and freedoms related to movement.

12. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuke et al in view of Ishizuka (US 6,716,043) as broadly as structurally claimed. Tuke discloses the claimed invention except for a tensioning means comprising a plurality of

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compressive coil springs wherein said springs are encapsulated in a plurality of segmented cylindrical spring housings wherein upper and lower segmented portions have different diameters and are slidably engaged. Ishizuka teaches the use of a plurality of compressive coil springs 12 for tensioning mean. Moreover, Ishizuka teaches a plurality of segmented cylindrical spring housings encapsulating said plurality of compressive coil springs wherein said segments are of differing diameters in order to be slidably engaged, best seen in Figures 2 and 4. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the measurement device as taught by Tuke, with the measurement device as taught by Ishizuka for the purpose of increasing the efficacy of a total knee arthroplasty by increasing surgical success via measuring anatomical constraints and freedoms related to movement.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuke et al in view of Ishizuka as applied to claims 7 and 8 above, and further in view of Weisman et al (US 3,722,100) as broadly as structurally claimed. Tuke in view of Ishizuka discloses the claimed invention except for segmented cylindrical housing having graduated indices for measuring distance. Weisman teaches a segmented cylindrical housing 16, 36 with graduated indices as seen in Figure 2 for measuring distance. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the measurement device as taught by Tuke in view of Ishizuka, with the measurement device as taught by Weisman for the purpose of increasing the

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efficacy of a total knee arthroplasty by increasing surgical success via measuring anatomical constraints and freedoms related to movement.

14. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuke et al in view of Ishizuka and Weisman as applied to claim 9 above, and further in view of Muhs. Tuke in view of Ishizuka in further view of Weisman discloses the claimed invention except for measuring angulation and additionally comprising a fixedly attached positioner. Muhs teaches measuring angulation by deviation of a planar member as it deviates from parallel wherein a positioner is fixedly attached to the lower tensioning surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the measurement device as taught by Tuke in view of Ishizuka in further view of Weisman, with the measurement device as taught by Muhs for the purpose of increasing the efficacy of a total knee arthroplasty by increasing surgical success via measuring anatomical constraints and freedoms related to movement.

Response to Arguments

15. Applicant's arguments with respect to claims 1, 2, 5, and 7-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH

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McHale

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